

REMARKS

Claims 1-14 and 23-27 are pending. By this Amendment, claims 1, 8, 23, and 27 are amended. The amendments to claims 1, 8, 23 and 27 are supported by the specification at, for example, page 3, lines 2-4. No new matter is introduced by the present Amendment.

Rejections Under 35 U.S.C. § 112, First Paragraph

The Examiner rejected claims 1-3, 5-10, 12-14, 23-25 and 27 under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement. More specifically, the Examiner asserted that independent claims 1, 8 and 23 include the alkylsulfonylphenyl group which is excluded by the specification. Applicants have amended claims 1, 8, and 23 to recite that neither R₁ nor R₂ is an alkylsulfonylphenyl group, a naphthyl group, a stilbenyl group or a (9H-fluoren-9-ylidene)benzyl group, and as such Applicants submit that independent claims 1, 8 and 23 comply with the written description requirement.

The Examiner also asserted that the combination where R₁ is a phenyl group and R₂ is a phenyl group is without basis in the specification as filed. Applicants note that the specification describes that R₁ and R₂ can be, independently, an alkyl group, an alkaryl group or an aryl group. See specification at, for example, page 3, lines 2-5. Furthermore, compound (3) on page 21 depicts a compound where both R₁ and R₂ are phenyl groups. As such, the specification provides adequate support for the combination where R₁ is a phenyl group and R₂ is a phenyl group.

The Examiner also asserted that “new claim 27 is without basis in the specification as filed because the specification does not disclose a charge transport compound where R₂ is a phenyl group and R₁ is alkyl, [alkaryl] or aryl.” As discussed above, the specification describes that R₁ and R₂ can be, independently, an alkyl group, an alkaryl group or an aryl group. See specification at, for example, page 3, lines 2-5. Furthermore, compound (3) on page 21 depicts a

compound where both R_1 and R_2 are phenyl groups. As such, the specification provides adequate support for claim 27.

Since the specification provides adequate written description for claims 1-3, 5-10, 12-14, 23-25 and 27, Applicants respectfully request the withdrawal of the rejection of claims 1-3, 5-10, 12-14, 23-25 and 27 under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement.

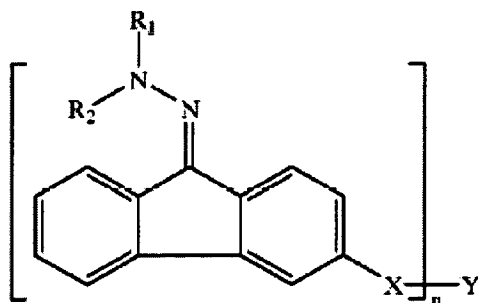
Rejections Under 35 U.S.C. § 112, Second Paragraph

The Examiner rejected claim 27 under 35 U.S.C. § 112, second paragraph, as being indefinite. More specifically, the Examiner asserted that “claim 27 contains two definitions for R_2 .” Applicants thank the Examiner for a close reading of the claims. Applicants have amended claim 27 such that only one definition of R_2 is recited, and submit that claim 27, as presently claimed, is definite. Since claim 27 is definite, Applicants respectfully request the withdrawal of the rejection of claim 27 under 35 U.S.C. § 112, second paragraph, as being indefinite.

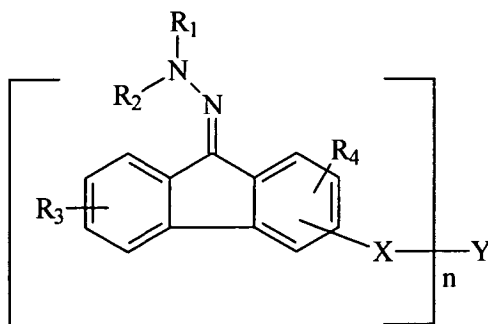
Rejections Under 35 U.S.C. § 102

The Examiner rejected claims 1, 3, 5-8, 10, 12-14, 23, 25 and 27 under 35 U.S.C. § 102(e) as being anticipated by U.S. Published Application 2003/0198880 (the ‘880 application). More specifically, the Examiner asserted that the ‘880 application “discloses a charge transport compound having an alkylsulfonylphenyl group as R_2 and an alkyl group as R_1 . Alkylsulfonylphenyl meets the requirements of a phenyl group because the instant claims permit substitution on a phenyl ring....” Applicants submit that the ‘880 application does not prima facie anticipate Applicants' invention, as presently claimed in independent claims 1, 8 and 23 and 27.

The '880 application relates to a charge transport material represented by the formula



where R₂ is an alkylsulfonylphenyl or one of its derivatives. In contrast, Applicants' invention, as presently claimed in independent claims 1, 8, 23 and 27, relates to a charge transport material having the formula



where neither R₁ nor R₂ is an alkylsulfonylphenyl group, a naphthyl group, a stilbenyl group or a (9H-fluoren-9-ylidene)benzyl group. Since the '880 application does not teach a charge transport material where neither R₁ nor R₂ is an alkylsulfonylphenyl group, the '880 application does not prima facie anticipate Applicants' invention, as presently claimed in independent claims 1, 8, 23 and 27.

Since the '880 application does not prima facie anticipate Applicants claimed invention, Applicants respectfully request the withdrawal of the rejection of claims 1, 3, 5-8, 10, 12-14, 23, 25 and 27 under 35 U.S.C. § 102(e) as being anticipated by U.S. Published Application 2003/0198880 (the '880 application).

Rejections Under 35 U.S.C. § 103

The Examiner rejected claim 27 under 35 U.S.C. § 103 as being unpatentable over the '880 application. Applicants note that the '880 application is only prior art under 35 U.S.C. § 102(e). Applicants further note that "subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person." See 35 U.S.C. § 103(c). Applicants submit that subject matter of the '880 application and the presently claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person. As such, the '880 application is not a proper reference for an obviousness rejection. Therefore, Applicants respectfully request the withdrawal of the rejection of claim 27 under 35 U.S.C. § 103 as being unpatentable over the '880 application.

Double Patenting Rejection

The Examiner provisionally rejected claims 8-10, 12-14 and 23-25 and 27 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 and 13-18 of copending Application No. 10/983,020. Applicants have included an appropriate Terminal Disclaimer to obviate the double patenting rejection and respectfully request the withdrawal of the rejection of claims 8-10, 12-14 and 23-25 and 27 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 and 13-18 of copending Application No. 10/983,020.

CONCLUSION

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,



Brian L. Jarrells
Registration No. 53,067

Customer No. 24113
Patterson, Thunte, Skaar & Christensen, P.A.
4800 IDS Center
80 South 8th Street
Minneapolis, Minnesota 55402-2100
Telephone: (612) 252-1535